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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,142	11/12/2003	Roger W. Phillips	78384 18-32DIV1	6069
27975 7590 03/28/2008 ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST P.A. 1401 CITRUS CENTER 255 SOUTH ORANGE AVENUE P.O. BOX 3791 ORLANDO, FL 32802-3791				
EXAMINER VARGOT, MATHEU'D				
ART UNIT 1791		PAPER NUMBER		
NOTIFICATION DATE 03/28/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

creganoa@addmg.com

Office Action Summary

Application No.

10/706,142

Applicant(s)

PHILLIPS ET AL.

Examiner

Mathieu D. Vargot

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 10/10/07.

1.The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Application 756,945 (see col. 7, lines 6-12 and lines 32-43).
The applied reference discloses making a security article by providing a transparent substrate which has two opposite faces, "one face carrying a layer showing light interference effects while the opposite face carries a layer having a metallic effect" –see col. 7, lines 10-12. At column 7, lines 32-38, the applied reference goes on to disclose that the metallic effect side would constitute a hologram, which would be sandwiched "in between the information showing a colour shift effect and the information showing a metallic effect". Note that either the metallic effect information or the color shift information can be "underneath or on top of the hologram or kinogram" -see col. 7, lines 42-43. It is submitted that this anticipates instant claim 1, since such clearly discloses having the color shift effect and the hologram on opposite sides of the substrate.

2.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of European Patent Application 756,945 or Uyama et al.

European -945 discloses the basic claimed method lacking essentially the aspect of providing a release layer on the substrate and hot stamping same to an object to provide the security article thereon (instant claim 7). As noted previously, this is nothing but conventional in the art and would have been an obvious feature in the process of European -945 to facilitate attachment of the security article to an object. A 103 rejection of instant claim 1 has been additionally made over newly applied European -945, in the event that this reference is seen not to anticipate the claim. Uyama et al is applied for reasons of record as set forth in paragraph 1 of the previous action.

3.Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Uyama et al or European Patent Application 756,945 in view of Coombs et al -530.

Uyama et al and European -945 are applied for reasons of record as is Coombs et al -530.

4.Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over of Uyama et al or European Patent Application 756,945 in view of the admitted prior art as set forth at page 2, lines 14-21 of the instant specification essentially for reasons of record. Ie, Uyama et al and European -945 are applied for reasons of record, with the admitted prior art teaching that the formation of a color shifting layer employing multilayer color flakes in a polymeric medium is well known in the art.

Clearly, this would have been an obvious way to make a color shifting layer in either of Uyama et al or European -945.

5.Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

In view of the 102 rejection made against claim 1 over European Patent Application 756,945, arguments directed to unexpected results and the exhibits and declarations submitted in May of 2007 are believed to be moot. If the instant invention is anticipated by the prior art, a declaration is not probative in assessing patentability. However, the 103 has also been maintained over Uyama et al and also made over newly applied European -945. European -945 is not concerned with the placement of the hologram with respect to the color shifting layer, although the reference teaches they would be on opposite sides. The point is, the reference does not appear to place any distinction between the exact location of these effects and it is respectfully submitted that there should not be any. Again, the exhibits were rather carefully reviewed and in at least Exhibits 2, 3, 4 and 6, any differences were marginal at best. While there admittedly exists some difference between the exhibits, it is believed that these differences do not rise to the level of any unexpected result as applicant appears to be suggesting. In other words, simply because the precise optical effect is a little different between the prior art and the instant, such does not necessarily mean the instant claims are patentable over the prior art. At most, it is a difference of degree and not kind. Arguments set forth at pages 2-4 of the previous final rejection are hereby repeated. There is absolutely no indication that the security articles provided by the

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instant method would be "unexpectedly" any better than those of the prior art in providing authenticity to a document, and that is what applicant is suggesting.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on 571 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
March 21, 2008

/Mathieu D. Vargot/
Primary Examiner, Art Unit 1791